

REMARKS

Claims 53, 54, 62, 63, 65-67, and 69 are pending in the present application. In the Office Action dated October 14, 2004, claims 53, 54, 62, 63, 66 and 67 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,276,996 to Chopra ("the Chopra patent"). Claims 64, 65, 68, and 69 were rejected under 35 U.S.C. 103(a) as being unpatentable over the Chopra patent. Claim 53 has been amended to include the limitations of dependent claim 64. Claim 69 has been amended to correct a typographical error. Claims 64 and 68 are cancelled.

The rejection of claims under 35 U.S.C. 103(a) that rely on the Chopra patent must be withdrawn because the Chopra patent, which as will be explained in more detail below, cannot be relied upon as prior art in supporting a rejection under 35 U.S.C. 103(a), in view of 35 U.S.C. 103(c). 35 U.S.C. 103(c) states:

"(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under [section 103] where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

The Chopra patent was filed on November 10, 1998, prior to the filing of the present application, and was granted on August 21, 2001, subsequent to the filing of the present application. Therefore, the Chopra patent represents prior art under 35 U.S.C. 102(e)(2).

With respect to common ownership, both the Chopra patent and the present application were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same entity, namely, Micron Technology, Inc. Assignment of the of the Chopra patent is shown on the cover page of the patent, and assignment of the present application is recorded at Reel/Frame number 010130 on July 20, 1999.

Therefore, under 35 U.S.C. 103(c), a rejection of the claims under 35 U.S.C. 103(a) that rely on the Chopra patent cannot be maintained, and consequently, must be withdrawn.

Claim 53 has been amended to include the limitations of dependent claim 64. Presently amended claim 53 recites, the lubricant additive is present in the lubricating planarizing solution in an amount between 0.1% and 10% wt/wt. As discussed in the Office Action dated October 14, 2004, the Examiner rejected dependent claim 64 under 35 U.S.C. 103(a). However, as explained above the Chopra patent cannot be used in a rejection under 35 U.S.C. 103(a) because it is disqualified as a reference. Thus, presently amended claim 53 cannot be properly rejected under 35 U.S.C. 103(a) because it contains the limitations of former dependent claim 54. Furthermore, claims depending from claim 53 are also allowable due to depending from an allowable base claim and further in view of the additional limitations recited in the dependent claims.

All of the claims remaining in the application (i.e., claims 53, 54, 62, 63, 65-67, and 69) are now clearly allowable. Favorable consideration and a timely Notice of Allowance are earnestly solicited.

Respectfully submitted,

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Enclosures:

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